

REMARKS/ARGUMENTS

This paper is in response to the Office Action dated February 16, 2006. Applicant has amended the application as set forth above. Specifically, Claims 17 and 52 have been canceled without prejudice and Claims 1, 3, 4, 9-12, 14, 15, 18-25, 33, 34, 37, 39 and 47-51 have been amended. Upon the entry of the amendments, Claims 1-16 and 18-51 are pending in this application. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the above amendments and the following remarks.

Discussion of Amendments to the Claims

The amendments to Claims 1, 9 and 37 are made to clarify and further define the invention. Claims 10-12, 14, 15, 18-25 and 47-50 have been amended in view of the amendment of their base claims. Support for the amendments to Claims 1, 9-12, 14, 15, 18-25, 37 and 47-50 can be found in, for example, Figures 3 and 5 and their description in the specification. Claims 3 and 4 have been amended to correct errors. Claims 33, 34, 37 and 51 have been amended to incorporate all limitations of Claim 1 and not to depend on Claim 1. Claim 39 has been amended to correct an error and depend on Claim 37. As such, Applicant respectfully submits that the amendments are fully supported by the application as originally filed and do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments.

Priority Document

Applicant gratefully notes that no priority document has been received by the Patent Office. Applicant will obtain and file a certified copy of the priority document before the issue fee payment in this application.

Discussion of Rejection Under 35 U.S.C. § 112

The Examiner rejected Claims 33-51 directed to a method under 35 U.S.C. § 112, second paragraph, as depending from Claim 1 directed to an apparatus. Applicant respectfully disagrees with the Examiner and submits that a method claim can depend from an apparatus claim. The MPEP at Section 821.04, among other sections, provides a ground for a method claim depending from an apparatus claim. Specifically, Claims 33-51 are directed to a method of using the

apparatus of Claim 1 and were previously requested to be rejoined upon allowance of Claim 1 in accordance with MPEP Section 821.04. *See* Applicant's Response to Restriction Requirement dated December 5, 2005. However, to expedite the prosecution of the application, Applicant has amended Claims 33, 34, 37 and 51 to incorporate all limitations of Claim 1 and not to depend from Claim 1. Applicant respectfully requests the withdrawal of this rejection.

Discussion of Rejection Under 35 U.S.C. § 102

The Examiner rejected Claims 1-32 and 52 under 35 U.S.C. § 102(b) as being anticipated by Yi (U.S. Patent No. 6,282,980). As set forth above, Claims 17 and 52 has been cancelled. Thus, the rejection of Claims 17 and 52 is now moot. Applicants respectfully submit that Yi does not anticipate Claims 1-16 and 18-32 as discussed below.

The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Disclosure of Yi

Yi discloses a hinge (10 in Figs. 4 and 5) having a hinge cam (30), a hinge shaft (20) and a hinge spring (40), as shown in Fig. 5. The hinge cam (30) has two peak portions (31), two valley portions (32) and two cam surfaces (32a, 32b). The hinge shaft (20) has a mountain-shaped portion (22). The hinge spring (40) urges the hinge cam (30) toward the hinge shaft (20). The hinge shaft (20) is rotatable about the Z axis (Fig. 5). As hinge shaft (20) rotates, the mountain-shaped portion (22) moves on the peak and valley portions (31, 32) of the cam (30).

Yi Does Not Anticipate Claim 1

Claim 1 is directed to a hinge for use with an electronic device. Applicant has amended Claim 1 to further define the claimed invention and to distinguish from the disclosure of Yi. The hinge of amended Claim 1 includes, among other features, a cam surface, which comprises a first

sliding surface and a second sliding surface. The first and second sliding surfaces cause first and second substantially spontaneous slidings of at least one cam following tip thereon, respectively. Further, first and second slidings cause first and second rotational movements of the rotatable member about the axis in a rotational direction, respectively. The first rotational movement is for a first angle, and the second rotational movement is for a second angle. The first angle is substantially greater than the second angle.

Applicant submits that Yi does not teach or suggest the foregoing features of Claim 1. As such, Yi does not anticipate Claim 1 and its dependent claims. Applicants respectfully request the withdrawal of the rejection.

Discussion of Double Patenting Rejection

The Examiner rejected Claims 1-52 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-25 of U.S. Patent No, 6,085,387 (the '387 patent). The Examiner asserted that Claims 1-25 of the '387 patent encompass the rejected claims.

Applicant has not determined whether any of Claims 1-25 of the '387 patent encompasses any of the pending claims, Claim 1-16 and 18-51. Nonetheless, Applicant respectfully submits that the Examiner's assertion does not lead to the determination of whether the pending claims are properly rejected under the judicially created doctrine of obviousness-type double patenting, as discussed below.

The MPEP states that the question to be asked for determining obviousness-type double patenting is whether the claim in the application define an invention that is merely an obvious variation of a claimed invention of a prior patent. The followings are excerpts from the MPEP section 804, II.B.1.

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would

provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis.

In the Office Action, the Examiner did not make the inquiry provided in the MPEP, i.e., whether the pending claims are merely obvious variation of the claims of the '387 patent or whether the pending claims fail to meet the nonobviousness requirement of 35 U.S.C. § 103 over the claims of the '387 patent. Rather the Examiner assert that the claims of the '387 patent encompass the rejected claims of this application, which is unrelated to the determination of the obviousness type double patenting rejection. As such, the Examiner provided neither proper assertions nor factual grounds to lead to the determination of the obviousness-type double patenting.

In addition, as discussed above, the hinge of amended Claim 1 includes, among other features, the first and second sliding surfaces cause first and second substantially spontaneous slidings of at least one cam following tip thereon, respectively. Further, the first and second slidings cause first and second rotational movements of the rotatable member, respectively. The first angle for the first rotational movement is substantially greater than the second angle for the second rotational movement. However, the '387 patent does not teach or suggest the foregoing features of Claim 1, among other features of the claims that the '387 patent does not teach or suggest. As such, the '387 patent does not establish a *prima facie* case of obviousness. Therefore, the '387 patent cannot be relied on to reject Claim 1 under the judicially created

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doctrine of obviousness-type double patenting. Withdrawal of the rejection is respectfully requested.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above.

In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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Dated: _____

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